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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/490,867

01/24/2000

Sam E. Kinney JR.

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VAN PELT, YI & JAMES LLP  
10050 N. FOOTHILL BLVD #200  
CUPERTINO, CA 95014

EXAMINER

LEMIEUX, JESSICA

ART UNIT

PAPER NUMBER

3693

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/490,867	<b>Applicant(s)</b> KINNEY, SAM E.	
	<b>Examiner</b> JESSICA L. LEMIEUX	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/31/2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Non-Final Office action is in response to the application filed on January 24<sup>th</sup>, 2000 and in response to the applicant's arguments/amendments filed on February 12<sup>th</sup>, 2009. Claims 1-10 and 16-20 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31<sup>st</sup>, 2009 has been entered.

#### ***Response to Arguments***

3. Applicant argues that the prior art does not specifically teach "that any transforming of any parameters occurs in producing its 'apples-to-apples' comparison." Examiner notes that these arguments are made with respect to the amended claims. Examiner disagrees with the applicant's conclusion that the pending claims as amended are in condition for allowance, as the amended claims have been considered but applicant's arguments are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must be (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. In addition to being tied to another statutory class, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Merely having "another statutory class" in the preamble and not in the body of the claim is also not sufficient to render the claim statutory.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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The particular machine tie or particular transformation must meet two corollaries to pass the test for subject matter eligibility. First, the use of the particular machine or transformation of the particular article must impose a **meaningful limit** on the claim's scope. So, a machine tie in only a field-of-use limitation would not be sufficient. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, the use of the particular machine or the transformation of the particular article must involve **more than insignificant "extra-solution" activity**. If the machine or transformation is only present in a field-of-use limitation or in a step that is only insignificant "extra-solution" activity, such a data gathering or outputting, the claim fails the M-or-T test, despite the presence of a machine or a transformation in the claim.

A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-5 fail to meet the above requirements since there is neither a physical transformation nor a sufficient tie to another statutory class, such as hardware. Thus, it is unclear as to whether or not the claims are mere processes that involve purely human labor and further the claims as amended can be read as solely software per se and examiner request actual physical hardware to be used..

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 and 16-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 7,249,085. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a transformed bid according to comparative bid parameters that is transmitted to the bidders.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 6 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, and 16 recite a first and second bidder comparative bid parameter. Examiner notes that it is unclear by the pending claim language whether or not these

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two parameters are the same or uniquely developed for the specified bidder and further whether or not a specific bidder can view both bidder views if they are uniquely developed. Appropriate correction is required.

Claims 1, 6, and 16 recite “comparative bid parameter value.” Examiner notes that it is unclear what is done if anything with the comparative bid parameter values. Appropriate correction is required.

Claims 1, 6, and 16 recite creating a first bidder view and creating a second bidder view. Examiner notes that it is unclear what is done if anything with these two views. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/38844, Johnson et al. (hereinafter Johnson) in view of US Patent Number 6,647,373 to Carlton-Foss further in view of US Patent Number 7,330,826 to Porat et al. (hereinafter Porat).

As per claims 1, 6 and 16  
Johnson teaches a method, system and apparatus for an auction between a plurality of potential bidders, comprising:  
a processor and a memory is configured to provide the processor with instructions (Figure1);

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generating a sequence of price values for a comparative bid parameter (page 16+);

creating a buyer view of the auction that includes a first value included in the sequence of generated values (page 16+).

Johnson does not specifically teach prior to displaying a price to a first potential bidder, transforming, using a characteristic of an auction item, said first value into a first bidder comparative bid parameter value, creating a first bidder view of the auction, for said first potential bidder, that includes the first bidder comparative bid parameter value, prior to displaying a price to a second potential bidder, transforming said first value into a second bidder comparative bid parameter value and creating a second bidder view of the auction, for said second potential bidder, that includes the second bidder comparative bid parameter value.

Carlton-Foss teaches ranking bids received in accordance with financial and an unspecified number of other qualitative and quantitative dimensions (column 3, lines 34-37, column 8, lines 1-14, column 10 and column 11 55+).

Porat teaches an auction between a plurality of potential bidders, comprising creating a buyer view of the auction that includes a first value included in the sequence of generated values, prior to displaying a price to a first potential bidder, transforming, using a characteristic of an auction item, said first value into a first bidder comparative bid parameter value, creating a first bidder view of the auction, for said first potential bidder, that includes the first bidder comparative bid parameter value, prior to displaying a price to a second potential bidder, transforming said first value into a second bidder comparative bid parameter value, and creating a second bidder view of the auction, for said second potential bidder, that includes the second bidder comparative bid parameter value (Figure 23-45; see especially Figure 39 and 42, column 31, lines 27-57, column 36, line 24- column 41, line 44).

Therefore it would have been obvious to one skilled in the art at the time of invention to modify Johnson to include prior to displaying a price to a first potential bidder, transforming, using a characteristic of an auction item, said first value into a first bidder comparative bid parameter value, creating a first bidder view of the auction, for said first potential bidder, that includes the first bidder comparative bid parameter value, prior to displaying a price to a second potential bidder, transforming said first value into a second bidder comparative bid parameter value and creating a second bidder view of the auction, for said second potential bidder, that includes the second bidder comparative bid parameter value as taught by Carlton-Foss and Porat to use a known technique to improve similar art in the same way.

As per claims 2, 7 and 17

Johnson further teaches predefining a series of price increments or decrements (page 15-16).

As per claims 3, 8 and 18

Johnson further teaches changing said predefined series of price increments or decrements in real-time during the auction (at least page 15).



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As per claims 4, 9 and 19

Johnson further teaches performing one of a linear transformation, non-linear transformation, and lookup table transformations simultaneously (page 16+);

As per claims 5, 10 and 20

Johnson further teaches performing a combination of linear, non-linear, and lookup table transformations simultaneously (page 16+).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA L. LEMIEUX whose telephone number is (571)270-3445. The examiner can normally be reached on Monday-Thursday 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica L Lemieux  
Examiner  
Art Unit 3693

/J. L. L./  
Examiner, Art Unit 3693  
November 2009

/Stefanos Karmis/  
Primary Examiner, Art Unit 3693